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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,804	05/11/2001	Takao Kasai	0445-0299P	5485
2292	7590	12/30/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 12/30/2003  
16

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/852,804	KASAI ET AL.
	Examiner Jacqueline F Stephens	Art Unit 3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 October 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-9,12 and 13 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-9,12 and 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-3, 5-9, 12 and 13 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7, 9, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul USPN 6217890 B1 in view of Hamajima et al. USPN 5865822.

Regarding claims 1, 12, and 13, Paul discloses an absorbent article comprising a liquid-permeable top layer 22, a liquid-impermeable leak-proof layer 20, and an absorbent layer containing a superabsorbent polymer (Abstract and col. 24, lines 17-32) between the top layer and the leak proof layer (col. 10, lines 29-49). Paul discloses an agent having a skin care effect that is activated on contact with moisture (col. 23, lines 66 through col. 24, lines 16). Paul does not disclose the superabsorbent polymer has a water absorption of 30 g/g or more in terms of physiological saline absorption measured after centrifugal dewatering. Hamajima discloses a superabsorbent polymer having a water absorption of 30 g/g or more in terms of physiological saline absorption measured after centrifugal dewatering for the benefits of providing a high absorption rate, particularly a high reabsorption rate, a high body fluid immobilizing capacity, and enhanced inhabitation of reflow of the body fluid from the absorbent member to the surface (col. 5, lines 28-33 and col. 7, lines 2-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the superabsorbent of Paul with the claimed absorption capacity for the benefits disclosed in Hamajima.

Paul/Hamajima disclose the claimed superabsorbent capacity. Therefore, it is reasonable to assume the skin care agent does not cause a substantial reduction in water absorbing performance per unit weight of the superabsorbent polymer. Paul discloses the agent contains a water-soluble viscosity enhancer (thickener) (col. 13, lines 55-64 and col. 15, lines 7-21).

Regarding claim 2, Paul/Hamajima discloses the agent is fixed on a skin-contacting surface of the article (Paul col. 17, lines 41-45).

Regarding claim 3, Paul/Hamajima discloses the agent comprises a water-soluble or water-dispersible plant extract (Paul col. 20, lines 51-65).

Regarding claims 5-7, Paul/Hamajima discloses the absorbent article comprises a liquid-retentive absorbent layer, a liquid-impermeable leak-proof layer, and an agent having an effect on the skin of a wearer on the skin-contacting surface of the article (Paul Abstract, col 17, lines 41-45). Paul/Hamajima further discloses the superabsorbent polymer has a water absorption within the claimed range (Hamajima col. 5, lines 28-33). Therefore, it is reasonable to assume the skin care agent does not cause a substantial reduction in water absorbing performance per unit weight of the superabsorbent polymer. Paul/Hamajima discloses the agent contains a water-soluble viscosity enhancer (thickener) (Paul col. 13, lines 55-64 and col. 15, lines 7-21).

Claim 7 , is a product-by-process claim, which is limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Regarding claim 9, Paul/Hamajima discloses the agent has a dissolving temperature of 30-100<sup>0</sup>C, which includes the claimed range of 40-100<sup>0</sup>C (Paul col. 16, lines 53-61).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Hamajima as applied to claim 5 above and further in view of Yanaki et al. (USPN 5538728) . Paul/Hamajima discloses the present invention substantially as claimed. However, Paul/Hamajima fails to disclose the water-soluble thickener comprises the claimed material. Yanaki discloses polysaccharide used as a thickener in a skin care composition (col. 3, lines 19-25 and col. 4, lines 11-14, and col. 8, lines 15-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate polysaccharide in the agent of Paul/Hamajima. Doing so would provide a water-soluble thickener that gives enhanced viscosity without providing a sticky feeling as taught by Yanaki.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens  
Examiner  
Art Unit 3761

December 28, 2003

  
GLENN K. DAWSON  
PRIMARY EXAMINER